

### **REMARKS**

Claims 22-42 are pending in the application. Claims 37-39 have been withdrawn. Claims 22-36 and 40-42 have been rejected. No claims have been allowed.

### **Examiner Interviews**

The undersigned and Examiner Lyle Alexander interviewed the application via telephone on June 2, 2011 and July 7, 2011. During the first interview, the undersigned explained the results achieved with the instant invention, namely, that the hydrophobic structured surface provided by the instant invention automatically guides liquid sample that is applied to the test element to the channel opening and prevents the liquid sample from adhering to the hydrophobic structured surface around the application zone. During this first interview, claim amendments were discussed and Examiner Alexander was generally favorably disposed to the discussed claim language and wanted to see a reference to the unexpected results achieved with the lotus surface of the instant invention.

During the second interview, specific claim amendments were discussed and the undersigned proposed a whereby clause to be added to claim 22 to which the Examiner was favorably disposed. During the second interview, the undersigned explained the results achieved with the instant invention with reference to Figs. 3a – 3c of the instant application. Unfortunately, the figures were of low quality and Examiner Alexander had difficulty appreciating the differences in the results depicted in Figs. 3a – 3c. Examiner Alexander thus suggested that better quality figures be submitted, e.g., by means of an inventor Declaration. Such inventor Declaration has been submitted on even date herewith.

Further, Applicants have amended claim 22 to correspond to the amendment which was discussed during the interviews and to which the Examiner was favorably disposed.

The undersigned wishes to thank Examiner Alexander for the helpful suggestions offered and courtesies extended during the telephone interviews.

### **Claim Rejections 35 U.S.C. § 102**

Claims 22-25, 29-36 and 40-42 were rejected as being anticipated by U.S. Patent No. 6,441,898 to Markart (“Markart”).

This rejection was discussed during the interview and Applicants explained in detail how their hydrophobic structured surface (i.e. lotus surface) was different from an ordinary hydrophobic surface as disclosed by Markart. The Examiner appreciated the undersigned's explanation and generally agreed that the hydrophobic structured surface of the instant application was distinguishable over Markart.

However, Examiner Alexander suggested some claim amendments that would help clearly distinguish independent claim 22 over Markart. In response, Applicants have now made the amendment to claim 22 discussed during the interviews.

The Examiner also noted that the whereby clause in claim 22 was largely functional and thus requested that the Applicants reference the results achieved with the instant invention by other means, such as with a Declaration. Applicants have submitted such a Declaration, as discussed in more detail below, but Applicants would also like to point out for the Examiner some case law that Applicants believe allows the Examiner to give due patentable weight to the whereby clause at the end of amended claim 22.

"[T]here is nothing intrinsically wrong with the use of [functional language] in drafting patent claims." In re Swinehart, 439 F.2d 210, 212 (C.C.P.A. 1971). In fact, a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP § 2173.05(g). Courts have "even recognized in the past the practical necessity for the use of functional language." In re Halleck, 421 F.2d 911 (C.C.P.A. 1970). "Functional language may also be employed to limit the claims without using the means-plus-function format." Microprocessor Enhancement v. Texas Instruments, 520 F.3d 1367, 1375 (Fed. Cir. 2008); also see K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1363 (Fed. Cir. 1991) ("The functional language is, of course, an additional limitation in the claim."); Wright Medical Technology, Inc. v. Osteonics Corp., 122 F.3d 1440, 1443-44 (Fed. Cir. 1997) (functional language analyzed as claim limitation).

Although amended claim 22 is already distinguishable over the cited art without the whereby clause, Applicants believe that the above-quoted precedent gives the Examiner authority to give patentable weight the whereby clause in his analysis.

In view of the amendments to claim 22, which were discussed during the telephone interviews, Applicants respectfully request that the rejection of claim 22 and dependent claims 24-36 be withdrawn.

Furthermore, independent method claims 40 and 42 have been amended to include limitations similar to those added to claim 22 and are thus patentably distinguishable over Markart for the same reasons as is amended claim 22. Furthermore, claims 40 and 42 now recite a method step of using the hydrophobic structured surface to guide the sample towards the channel while preventing the sample from adhering to the hydrophobic structured surface formed in the area around the channel. To the extent that there is any issue concerning whether the whereby clause recited in claim 1 can be given patentable weight, this issue is not present with claims 40 and 42 because such claims are method claims and the recitation just noted is a positively recited method step. Applicants thus respectfully request that the rejection of independent claims 40 and 42 and dependent claim 41 be withdrawn.

#### **Claim Rejections 35 U.S.C. § 103**

Claims 26-28 were rejected as obvious over Markart. This rejection was also discussed during the interview and Examiner Alexander noted that he viewed his position differently in view of the undersigned's explanation of the hydrophobic structured surface of the instant invention and the results achieved thereby. Applicants thus respectfully request that the obviousness rejection of claims 26-28 also be withdrawn.

#### **Declaration**

Submitted on even date herewith is the Declaration of inventor Martin Frank, which includes as an Exhibit A attached thereto higher resolution copies of Figs. 3a – 3c. While the resolution of the photographs submitted in Exhibit A of the inventor's Declaration are of better quality than the ones submitted with the application as filed, the resolution is still somewhat limited. Nevertheless, the inventor affirms in his sworn Declaration the differences in the results achieved between the test elements formed with the instant invention (Fig. 3a) and the contamination observed in the test elements formed in accordance with the prior art (Figs. 3b and 3c). While the contamination in prior art Fig. 3b can be seen in all test strips of Fig. 3b, the contamination of the test elements shown in Fig. 3c is more difficult to discern. The inventor

affirms, however, that “there was observable contamination in all of the test elements shown in Fig. 3c around the channel opening when [he] closely examine the actual test elements during the test that resulted in the photos in Fig. 3c.” See Declaration, pg. 4, § 8.g.

Applicants believe that they have now satisfied the Examiner’s request for documenting the results achieved with the instant invention.

Applicants respectfully request entry of the Declaration and claim amendments and an indication of allowance of the pending claims. On behalf of the Applicants, the undersigned again thanks the Examiner for the willingness to conduct multiple interviews to discuss the application and for bringing issues to Applicants’ attention so they could be addressed.

[THIS SPACE INTENTIONALLY LEFT BLANK]

## CONCLUSION

Applicants submit that this is a complete response to the outstanding Office Action and further submit that all pending claims are allowable, and earnestly solicit allowance thereof.

If necessary, Applicants request that this response be considered a request for an extension of time appropriate for the response to be timely filed. Applicants request that any required fees needed beyond those submitted with this response be charged to the deposit account of Bose McKinney & Evans, Deposit Account No. 02-3223.

Should the Examiner have any questions regarding this response or the above-identified application in general, it is requested that he telephone Applicants' undersigned attorney.

Respectfully submitted,

BOSE McKINNEY & EVANS LLP

/Michael C. Bartol/

Michael C. Bartol

Reg. No. 44,025

Date Submitted: August 1, 2011

Bose McKinney & Evans LLP  
111 Monument Circle Suite 2700  
Indianapolis, Indiana 46204  
(317) 684-5000

1959662\_1